

REMARKS**I. General**

Claims 98-100, 106-112, 117, 120-123, and 125 are pending. The issue raised in the Office Action mailed July 20, 2004 is:

- Claims 98-100, 106-112, 117, 120-123, and 125 are subject to a restriction requirement whereby restriction to one of the following six groups is required under 35 U.S.C. § 121:
 - Group I: Claims 98-100;
 - Group II: Claim 106;
 - Group III: Claims 107-112;
 - Group IV: Claims 117 and 120-122;
 - Group V: Claim 123; and
 - Group VI: Claim 125.

II. Response to Restriction Requirement

Applicant respectfully traverses the restriction requirement. However, in an effort to speed up prosecution of the pending case, Applicant elects Group III consisting of claims 107-112 for further examination. In addition, Applicant's restriction is made without prejudice, and Applicant reserves the right to represent any of the claims of Groups I, II, IV, V, and VI at a later time.

III. Previous Rejection of Claims 107-112 Under 35 U.S.C. § 103

The Examiner previously rejected claims 107-112 under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent No. 6,331,972 to Harris et al. (hereinafter *Harris*). This rejection was set forth by the Examiner in the Office Action dated January 27, 2004. Applicant respectfully traverses this rejection and asserts that the rejected claims are allowable at least for the reasons stated below.

To establish a prima facie case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the

art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. §2143. Without conceding any other criteria, Applicant respectfully asserts that the rejection does not satisfy at least the first and third criteria, and therefore, claims 107-112 are patentable under 35 U.S.C. § 103(a).

A. Failure to teach or suggest all claim limitations

1. Independent Claims

Claim 107

Claim 107 requires, in part:

identifying a geographic area for a customer who has initiated a transaction using a wireless device, said identifying step accomplished by determining a specific wireless cell that is in communication with said customer's wireless device;

if more than one of said point of sale locations are within said geographic area, then prompting said customer to select a point of sale location from a list of said point of sale locations within said geographic area, and communicating financial data for a selected point of sale location to said customer's wireless device over said wireless network.

The disclosure of *Harris* fails to disclose these features of claim 107. The Examiner fails to specifically state which portion of *Harris* is relied upon in rejecting these features of claim 107. Therefore, based on the Examiner's assertions, Applicant assumes the Examiner relied on the portions of *Harris* discussed below in rejecting claim 107. *Harris* discloses various relationships between peers in a capability addressable, wireless, peer-to-peer data communication network that supports an unlimited number of connections between peers. (*Harris*, col. 6, lns. 10-20). In addition, *Harris* discloses a sequence of data exchange messages that take place during a financial transaction between a personal transaction and storage device (407), and the various objects (454, 456, 458, 460) that are involved with a particular financial transaction. (*Harris*, col. 23, lns. 1-12). However, the disclosure of a wireless peer-to-peer communication network and a sequence of data exchanges that occur during a financial transaction fails to teach or suggest the identifying of a geographic area for a customer who has initiated a transaction using a wireless device that is accomplished by determining a specific wireless cell that is in communication with the customer's wireless device and also fails to teach or suggest that if more than one point of sale location is within

the geographic area, then prompting the customer to select a point of sale location from a list of the point of sale locations within the geographic area, and communicating financial data for a selected point of sale location to the customer's wireless device over the wireless network. Thus, *Harris* fails to teach all the elements of claim 107. Therefore, Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of claim 107 be withdrawn.

2. Dependent Claims

Claims 108-112 depend directly from base claim 107 and thereby inherit all of the respective limitations. Accordingly, it is respectfully submitted that the dependent claims are allowable based on at least their dependency from independent base claim 107, and for at least the reasons discussed above. Thus, Applicant respectfully submits that based on the arguments above, claims 108-112, are patentable under 35 U.S.C. § 103.

B. Lack of Motivation

It is well settled that the teaching or suggestion to make the claimed combination must be found in the prior art, and not based on the level of skill in the art. M.P.E.P. §2143, citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999). The Examiner concedes that *Harris* fails to disclose displaying a list of point-of-sale device locations. However, the Examiner attempts to cure the deficiencies of *Harris* by asserting that to display a list of point-of-sale device locations would have been obvious to one of ordinary skill in the art. (Office Action dated January 27, 2004 at page 2). The mere assertion that it would have been obvious to one of skill in the art does not establish the presence of a suggestion within the prior art to make the claimed combination. Furthermore, the Examiner's assertion that displaying a list of point of sale device locations (1) is known from advertising, (2) is the type of information contained in a wallet, and (3) is known from the varied use of advertising slogans and the varied use of making a pitch for a product using varied terms fails to establish motivation for providing a list of point of sale device locations. Thus, the Examiner fails to provide proper motivation for adding the displaying of a list of point of sale locations.

Impermissible Hindsight

Furthermore, Applicant respectfully asserts that the Examiner is relying on impermissible hindsight in order to piece together the elements of the claims based on

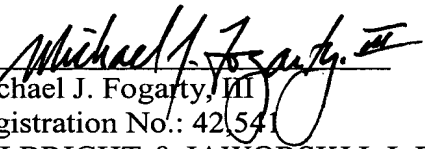
knowledge gleaned from Applicant's disclosure. *Harris* discloses a financial transaction where a buyer uses a barcode reader to scan product barcodes to begin a financial transaction. (*Harris*, col. 23, lns. 30-40). After scanning the product, the buyer provides banking information to the merchant. The merchant then initiates a banking request to the merchant's bank so that the merchant's bank can initiate an appropriate financial transaction with the buyer's bank, such as a simple transfer request to cover the cost of the requested purchase. (*Harris*, col. 23, lns 50-60). However, *Harris* makes no mention of providing information pertaining to point of sale device locations, such as a list of point-of-sale device locations or which point of sale device locations are within a geographic area. Thus, Applicant asserts that without the teachings of Applicant's disclosure one of ordinary skill in the art would not find it obvious to provide data pertaining to point of sale device locations from the disclosure of *Harris*. However, as stated above, the teaching or suggestion to make the claimed combination must be found in the prior art, not in Applicant's disclosure. See M.P.E.P. §2143, citing *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Thus, the motivation to combine provided by the Examiner is improper, as the motivation must be described in a prior art reference and must detail the benefits of such a modification. M.P.E.P. § 2145 (X). Therefore, Applicant respectfully requests that the Examiner provide proper motivation for such combination or that the rejection under 35 U.S.C. § 103 be withdrawn.

IV. Summary

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 51410/P003US/09705003 from which the undersigned is authorized to draw.

Dated: August 20, 2004

Respectfully submitted,

By 
Michael J. Fogarty, III
Registration No.: 42,541
FULBRIGHT & JAWORSKI L.L.P.
2200 Ross Avenue, Suite 2800
Dallas, Texas 75201-2784
(214) 855-8172
(214) 855-8200 (Fax)
Attorney for Applicant